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CASE 4-30879A/CO 211

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF

Art Unit: 1624

PAIVI JAANA KUKKOLA

Examiner: T. Truong

APPLICATION NO: 09/533,219

FILED: MARCH 23, 2000

FOR: THYROMIMETIC ORGANIC COMPOUNDS

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE

Sir:

This is in response to the Office Action of December 31, 2001 on the above-identified Application no. 09/533,219.

The claims under consideration are claims 9, 11, 14, 16-19 and 21-25.

The applicant respectfully requests reconsideration of the rejection of claims 9, 11, 14, 16-19 and 21-25 under 35 U.S.C §102(e) as being anticipated by Chiang et al. (U.S. Patent No. 6,326,398).

The instant application claims the benefit of U.S. provisional application No. 60/183,030 filed March 29, 1999 (which was converted from non-provisional application No. 09/250,105).

Chiang et al. U.S. Patent No. 6,326,398 claims the benefit of provisional application No. 60/122,292 filed March 1, 1999.

Both priority applications are of record in the instant application. A copy of a certified copy of application No. 60/122,292 was made of record with Information Disclosure Statement filed October 25, 2000. A certified copy of provisional application No. 60/183,030 was submitted with communication filed November 14, 2000.

The broadest compound claim of the instant invention, claim 9, claims a single compound, pharmaceutically acceptable salts thereof, and pharmaceutically acceptable prodrug esters thereof. The compound as such, i.e., N-{4[3-(4-fluorobenzenesulfonyl)-4-hydroxyphenoxy]-3,5-dimethylphenyl}oxamic acid, is claimed in the instant claim 22. Its structure is depicted in example 26 on page 31 of the application.

Regarding the instant claims, it is respectfully submitted that the subject matter claimed in the instant claims 9, 11, 14, 16-19 and 21-25 is supported by parent provisional application No. 60/183,030 filed on March 29, 1999. For example, Example 25 on page 31 is directed to the compound of the instant claim 22 and corresponds to example 26 in the instant application. Also, the subject matter of instant claim 9 is claimed in claim 8 of said parent application.

U.S. Patent No. 6,326,398 which issued on December 4, 2001 and was filed on February 28, 2000, names the compound of the instant claim 22 in column 10, lines 50 and 51. However, no such disclosure appears in priority provisional application No. 60/122,292 filed March 1, 1999. Furthermore, in the Chiang et al. priority application the preferred groups of compounds of formula I wherein R^4 is $-S(O)_2R^{12}$ do not even encompass the compound of the instant claim 22 (please see third and fourth paragraphs on page 10).

In view of the above, it is respectfully submitted that regarding the instant claims 9, 11, 14, 16-19 and 21-25, U.S. 6,326,398 cannot be effective as a prior art reference for anticipation under 35 U.S.C §102(e) as of the March 1, 1999 filing date of its priority application.

In contrast thereto, the priority application of the instant application supports the instant claims 9, 11, 14, 16-19 and 21-25, and its filing date, March 29, 1999, is prior to the February 28, 2000 filing date of U.S. Patent No. 6,326,398.

Therefore, it is respectfully submitted that the rejection of the instant claims 9, 11, 14, 16-19 and 21-25 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,326,398 is overcome and should be withdrawn.

Relating to Chiang et al., U.S. Patent No. 6,326,398, the Applicant would also like to call to the Examiner's attention that reduction to practice of the instant invention occurred prior to the March 1, 1999 filing date of the Chiang et al. provisional application.

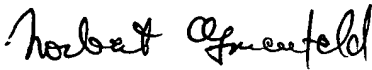
Reconsideration of the provisional non-statutory double patenting rejections over co-pending Applications No. 09/696,502 and No. 09/702,634 is respectfully requested.

Provided that the instant claims are now otherwise allowable, and since the co-pending applications No. 09/696,502 and No. 09/702,634 have not yet been allowed, the Examiner is respectfully requested to withdraw both provisional rejections and permit the instant application to issue as a patent in accordance with MPEP 804 (Section B on page 800-19).

It is respectfully submitted that all the instant claims are believed to be in condition for allowance and such is earnestly solicited.

Respectfully submitted,

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